

Appl. No. : 09/715,850
Filed : November 17, 2000

REMARKS

Claims 1-31 are pending in the present application. In the March 25, 2004 Office Action, Claims 1-8, 10-16, 19-28, and 31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over PlanetAll-related references cited as Items U-V in the PTO-892 form accompanying the Office Action (hereinafter, "PlanetAll), in view Amazon-related references, cited as Item W-X in the PTO-892 form (hereinafter, "Amazon"). Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over PlanetAll and Amazon, and further in view of the Carroll reference (Item UU in the PTO-892 form accompanying the Office Action). Claims 17 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over PlanetAll and Amazon as applied to Claim 1. Claim 29 was rejected under 35 U.S.C. § 103(a) as being unpatentable over PlanetAll and Amazon as applied to Claim 20. Claim 30 was rejected under 35 U.S.C. § 103(a) as being unpatentable over PlanetAll and Amazon and further in view of Official Notice regarding book reviews.

Because none of the cited references, alone or in combination, teach or suggest the invention as claimed, Applicants respectfully traverse the Examiner's rejection of Claim 1-31 and respectfully requests that the Examiner withdraw the rejection and allow Claims 1-31.

In addition, Claim 1, 3, 5-22, and 24-31 have been amended to provide further clarification and to correct typographical errors.

Discussion of Claims 1-8, 10-31

Neither PlanetAll nor Amazon are concerned with or even mention sharing historical purchase information. Therefore, with respect to Claim 1, neither PlanetAll nor Amazon teach or suggest:

receiving over the network authorization from the first user to share at least a portion of historical purchase information with a second user, wherein the first user selectively designates which historical purchase information is to be shared;

Further, because neither PlanetAll nor Amazon are concerned with or even mention sharing historical purchase information, the cited references fail to teach or suggest, with respect to Claim 1:

receiving n over the network authorization from the second user to share at least a portion of historical purchase information for the second user with a third user,

Appl. No. : 09/715,850
Filed : November 17, 2000

wherein the second user selectively designates which historical purchase information is to be shared;

The cited references similarly fail to teach or suggest:

at least partly in response to the authorization received from the second user, enabling the third user to access at least a portion of the first user's historical purchase information over the network.

Indeed, rather than being concerned with historical purchase information, much less sharing historical purchase information, PlanetAll appears to be specifically directed to tracking the whereabouts of friends, letting a user know when the user's travel plans overlaps with a friends' travel plans, notifying a user of upcoming birthdays, holidays, and events that the user specifies (PlanetAll, Item V, page 1). PlanetAll does not even appear to mention purchasing items, and is not concerned with purchased items and historical purchase information, or the sharing of historical purchase information.

Because PlanetAll is not concerned with and does not mention historical purchase information, there would be no motivation to modify PlanetAll with Amazon as proposed by the Examiner. Further, Amazon likewise fails to even mention users sharing historical purchase information.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Here, the Examiner has not identified an adequate motivation to modify PlanetAll with Amazon so as to share historical purchase information, much less to receive authorization from a first user to share at least a portion of historical purchase information with a second user, wherein the first user selectively designates which historical purchase information is to be shared, or to receive authorization from the second user to share at least a portion of historical purchase information for the second user with a third user, wherein the second user selectively designates which historical purchase information is to be shared, or to, at least partly in response to the authorization received from the

Appl. No. : 09/715,850
Filed : November 17, 2000

second user, enable the third user to access at least a portion of the first user's historical purchase information.

Furthermore, because PlanetAll is not concerned with sharing historical purchase information, no such motivation exists.

The Examiner admits that neither PlanetAll nor Amazon even discloses retrieving past purchase information for a first customer and sharing a portion with a second customer. Nonetheless, the Examiner argues that it would have been obvious to one of ordinary skill in the art at the time of the invention to disclose retrieving past purchase information of a first customer, sharing a portion with a second customer, since it is well within the skill to ascertain that customer-to-customer communication of past purchase history influences buying decisions.

Applicants are not certain what the Examiner means by the statement that it would have been obvious to one of ordinary skill in the art at the time of the invention to disclose retrieving past purchase information of a first customer, sharing a portion with a second customer, since it is well within the skill to ascertain that customer-to-customer communication of past purchase history influences buying decisions. Applicants assume the Examiner means to say that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify PlanetAll to retrieve past purchase information of a first customer, and share a portion with a second customer, since it is well within the skill to ascertain that customer-to-customer communication of past purchase history influences buying decisions.

However, as similarly discussed above, because neither PlanetAll nor Amazon are even concerned or mention sharing historical purchase information, there would be no motivation to modify PlanetAll as proposed by the Examiner. Further, because neither PlanetAll nor Amazon are even concerned or mention sharing historical purchase information, even if PlanetAll was modified with the disclosure of Amazon the result would still not retrieve past purchase information of a first customer and share a portion with a second customer as proposed by the Examiner.

Furthermore, even assuming *arguendo*, that there were a motivation to modify PlanetAll with Amazon as proposed by the Examiner, and even assuming *arguendo*, that the result would retrieve past purchase information of a first customer and share a portion with a second customer as proposed by the Examiner, the Examiner has provided no motivation to modify PlanetAll to provide a method including:

Appl. No. : 09/715,850
Filed : November 17, 2000

receiving authorization from the first user to share at least a portion of historical purchase information with a second user, wherein the first user selectively designates which historical purchase information is to be shared; receiving authorization from the second user to share at least a portion of historical purchase information for the second user with a third user, wherein the second user selectively designates which historical purchase information is to be shared; and at least partly in response to the authorization received from the second user, enabling the third user to access at least a portion of the first user's historical purchase information

as claimed. The Examiner has therefore failed to make a prima facie case in rejecting Claim 1. The Examiner has similarly failed to provide a motivation to modify PlanetAll with the disclosure of Amazon to transmit historical purchase information for the first user over the network to the second user and the third user and so had failed to make a prima facie case in rejecting Claim 2. The Examiner has similarly failed to provide a motivation to modify PlanetAll with the disclosure of Amazon to transmit information over the network to the second user indicating who has received authorization to receive at least a portion of the first user's purchase history, and so had failed to make a prima facie case in rejecting Claim 3.

With respect to Claim 4, as similarly discussed above with respect to Claim 1, the Examiner has failed to provide a motivation to modify PlanetAll with the disclosure of Amazon to receive over a network a customer authorization permitting at least a second customer to view information on at least a portion of the first customer's purchases, receive over the network a customer specification as to which customer purchases information may be viewed by the second customer, and provide an electronic notification to the second customer, wherein the notification informs the second customer of the first customer authorization, and as similarly discussed above, no such motivation exists. The Examiner therefore has failed to make a prima facie case in rejecting Claim 4. Applicants similarly traverse the rejection of Claims 5-8, and 10-22.

With respect to Claim 23, as similarly discussed above with respect to Claims 1 and 4, the Examiner has failed to provide a motivation to modify PlanetAll with the disclosure of Amazon to receive over a network from the first user a selection as to which of the listed first user's purchases are to be shared with other users, and to receive over the network information from the first user designating which other users may view the first user's selected purchases. Further, as similarly discussed with respect to Claim 1, no such motivation exists. The Examiner

Appl. No. : 09/715,850
Filed : November 17, 2000

therefore has failed to make a prima facie case in rejecting Claim 23. Applicants similarly traverse the rejection of Claims 24-28, and 30-31.

Similarly, in rejecting Claim 29, the Examiner argues that it would have been obvious to one of ordinary skill in the art to disclose the first customer editing past purchase information to be shared with a second customer, since it is well with the skill to ascertain that a first customer can edit personal information to be viewed by a second customer. However, the Examiner has offered no motivation to modify PlanetAll and Amazon to provide the claimed invention, and so the Examiner has again failed to make a prima facie case of obviousness.

In view of the foregoing discussion, Applicants respectfully request that the Examiner withdraw the rejection to independent Claims 1, 4, 23 and to allow independent Claims 1, 4, and 23. Applicants further request that the Examiner withdraw the rejection of Claims 1-8, and 10-31, which depend from their respective independent claims and further define the respective independent claims, and to allow 1-8, 10-31.

Discussion of Claim 9

With respect to Claim 9, the Examiner admits that neither PlanetAll nor Amazon disclose a one-use token in an email notification. Nonetheless, the Examiner states that Carroll teaches PlanetAll email notifications bouncing back because email accounts were dead. The Examiner argues that it would have been obvious to one of ordinary skill in the art at the time of the invention to halt email notification if an email account does not match any email address as taught by Carroll, in order to prevent repeated attempts on a dead email account, and thereby prevent efficient use of computing resources.

Claim 9 recites "including a one-use token in the notification if the second customer's e-mail address does not match any e-mail addresses stored in a customer database associated with the electronic commerce entity." Carroll, by contrast, teaches that email address are in the system, (in the members e-mail address books stored on the system), but that certain email addresses in the system are associated with dead e-mail accounts. Thus, for example, in Carroll there is no "match" of an email address provided by a first customer in an authorization to determine if that email address is in the PlanetAll system and so whether to include a one-use token. Furthermore, including a one-use token in a notification sent to a dead email address would not prevent repeated attempts on the dead email account as argued by the Examiner.

Appl. No. : 09/715,850
Filed : November 17, 2000

Applicants therefore respectfully traverse the Examiner's rejection of Claim 9, and respectfully request that the Examiner withdraw the rejection of Claim 9 and allow Claim 9.

Summary

In view of the foregoing remarks and amendments, Applicants respectfully submit that independent Claims 1, 4, and 23 are patentably distinct over the cited art and are in condition for allowance. Claims 2-3, 5-22, and 24-31, which correspondingly depend from independent Claims 1, 4, and 23 and further define Claims 1, 4, and 23, are likewise patentably distinct over the cited art and are in condition for allowance. Applicants therefore respectfully request withdrawal of the rejection of Claims 1-31, and requests that the Examiner allow Claims 1-31.

Request for Telephone Interview

If there are any issues that can be resolved by telephone, the Examiner is respectfully requested to call the undersigned attorney of record at (310) 407-3461 or at the number set forth below.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: June 25, 2004

By: 

David N. Weiss
Registration No. 41,371
Attorney of Record
Customer No. 20,995
(310) 551-3450

L:\DOCS\DNW\DNW-6346.DOC
052104